REMARKS

By this Amendment, Applicants have amended claims 1-3 and 17. Support for these amendments are found, for example, at page 18, line 12 – page 20, line 5 of the specification. Claims 1-3 and 17 are pending in this application, with claims 4-16 and 18-24 being withdrawn from consideration by the Examiner.

In the Office Action dated February 10, 2005, the Examiner objected to the title of the invention and rejected claims 1-3 and 17 under 35 U.S.C. § 103(a), as being unpatentable over Torres et al. (U.S. Patent No. 6,738,075) in view of Vetro et al. (U.S. Patent No. 6,542,546). For the reasons stated below, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 103(a) and request allowance of the present application.

I. The Objection to The Title of The Invention.

The Examiner objected to the title of the invention. Accordingly, Applicants have amended the title to be more descriptive. Therefore, Applicants respectfully request the Examiner to withdraw the objections to the title of the invention.

II. The Rejection of Claims 1-3 and 17 Under 35 U.S.C. § 103).

Claims 1-3 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Torres et al. in view of Vetro et al. Applicants respectfully traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the

claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *See* M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. *See* M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

Claim 1 recites "[a] video camera apparatus utilizing a network and a recording medium," including *inter alia* "a mode selector to select a first shot mode for obtaining a high quality motion video file or a second shot mode for obtaining a compression-encoded motion video file suitable for real time transmission via the network" and "a control section configured to execute the second shoot mode to control said video encoding section to match a bit rate of an encoded video signal obtained by said video encoding section with a communication speed of the network used to transmit the video file when the second shoot mode is selected." These features are neither discussed nor suggested by the asserted prior art.

Torres et al. fails to disclose or teach at least these limitations. Torres et al. discloses a method and apparatus for creating an interactive slide show in a digital imaging device. (*See* Abstract.) To this end, Torres et al. discloses a digital video camera comprising an image device 110, a video codec 132 for compressing a digital video, and a mass storage device 122 for storing an image file. (*See* FIG. 1 and Col. 5, lines 36-46.) Further, Torres et al. teaches the use of an e-mail address in FIG. 4A. However, Torres et al. does not teach or suggest at least "a mode selector to select a first shot mode

for obtaining a high quality motion video file or a second shot mode for obtaining a compression-encoded motion video file suitable for real time transmission via the network," as recited in claim 1. Moreover, as acknowledged by the Examiner, Torres et al. fails to teach or suggest "a control section configured to execute the second shoot mode to control said video encoding section to match a bit rate of an encoded video signal obtained by said video encoding section with a communication speed of the network used to transmit the video file when the second shoot mode is selected," as recited in claim 1.

Vetro et al. does not make up for the deficiencies of Torres et al. That is, Vetro et al. also fails to teach or suggest at least "a mode selector to select a first shot mode for obtaining a high quality motion video file or a second shot mode for obtaining a compression-encoded motion video file suitable for real time transmission via the network" and "a control section configured to execute the second shoot mode to control said video encoding section to match a bit rate of an encoded video signal obtained by said video encoding section with a communication speed of the network used to transmit the video file when the second shoot mode is selected," as recited in claim 1.

At page 4 of the Office Action, the Examiner alleges that Vetro et al. teaches "that in the context of video transmission, compression standards are needed to reduce the amount of bandwidth (available bit rate) that is required by the network. While this may be true, Applicants respectfully submit that this teaching is not sufficient to establish a *prima facie* case of obviousness when taken in any combination with Torres et al. Vetro et al. does not teach or suggest a digital camera capable of transmitting a captured video image but a multi-media delivery system for delivering a compressed bitstream through a network to a user device. (*See* Abstract.) Further, there is no suggestion of controlling the video

encoding section to match a bit rate of an encoded video signal, as alleged by the Examiner, and the teachings of Vetro et al. do not provide sufficient motivation to provide the claimed mode selector or control section in Torres et al. Therefore, Torres et al. alone or in combination with Vetro et al. fails to teach or suggest "a mode selector to select a first shot mode for obtaining a high quality motion video file or a second shot mode for obtaining a compression-encoded motion video file suitable for real time transmission via the network" and "a control section configured to execute the second shoot mode to control said video encoding section to match a bit rate of an encoded video signal obtained by said video encoding section with a communication speed of the network used to transmit the video file when the second shoot mode is selected," as recited in claim 1.

Since the cited references, taken either alone or in any reasonable combination, fail to teach each and every element required by claim 1, no *prima facie* case of obviousness has been made out with respect to this claim. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claim 1 under 35 U.S.C. § 103 as being obvious from Torres et al. in view of Vetro et al.

Claims 2-3 depend from claim 1. As explained, claim 1 recites elements not disclosed or suggested by Torres et al. and Vetro et al. Accordingly, claims 2-3 are allowable over Torres et al. and Vetro et al. for at least the same reasons as claim 1. Furthermore, claims 2-3, as amended, recited additional features that are neither taught nor suggested by Torres et al. and Vetro et al. Applicants therefore respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claim 17, although of different scope, includes elements similar to that discussed above with regard to claim 1. Applicants therefore request the Examiner to withdraw the rejection of claim 17 for at least the same reasons discussed above with respect to claim 1

III. Conclusion

In view of the foregoing remarks, Applicants submit that the claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited in the Office Action. Applicants, therefore, request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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